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10/552,259	05/31/2006	Baumgart Hubert	PAT-01084	6541
26/922	7590	09/12/2008		
BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192			EXAMINER BERMAN, SUSAN W	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			09/12/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/552,259

**Applicant(s)**

HUBERT ET AL.

**Examiner**

/Susan W. Berman/

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/08)  
Paper No(s)/Mail Date 10-5-05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed, short and concise. The title should mention that the mixture contains an isocyanate compound and a photoinitiator and is useful in a two component coating composition.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19, 25-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hovestadt et al (6,335,381). Hovestadt et al disclose both the isocyanate-functional mixture with a photoinitiator set forth in instant claim 1 and the two component system comprising the claim 1 mixture and a isocyanate-reactive component set forth in instant claim 14. See Example 3. The urethane acrylate contains free isocyanate groups. Component II comprises a polyacrylate having hydroxyl groups and no photoinitiator. Hovestadt et al teach that component I can also contain a further polyisocyanate. With respect to claims 12, 16 and 17, although the examples include a diacrylate, Hovestadt et al do not teach that components other than the isocyanate compound are required in component I (see column 2, lines 26-39). With respect to claim 25, dual cure and

coating of automotive parts are taught in column 5, lines 27-45. With respect to claim 26, the coatings would be expected to be clearcoat coatings because no pigments or fillers are added to the coating compositions.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hovestadt et al (6,335,381) as applied to claims 1-19, 25-26 and 28 above, and further in view of Baumgart et al (7,064,165). Hovestadt et al do not mention effect paints or multicoats. Baumgart et al disclose coating materials for multicoat systems comprising components analogous to those instantly claimed. Addition of photoinitiators is taught. The difference is that the photoinitiator is not added to the isocyanate crosslinking component B, as set forth in the instant claims. The compositions are said to be "outstandingly suitable" for multicoat clearcoats (column 19, lines 46-54). It would have been obvious to one skilled in the art at the time of the invention to provide multicoat clearcoats obtained from the coating compositions disclosed by Hovestadt et al, as taught by Baumgart et al. The reason is that Baumgart et al teach that analogous compositions provide "outstandingly suitable" multicoat clearcoats. One skilled in the art at the time of the invention would have been motivated by a reasonable expectation of providing a multicoat clearcoat from the analogous coating materials taught by Hovestadt et al.

### ***Conclusion***

The following references are cited as art of interest.

Lettmann et al (6,946,515) disclose dual curing coating materials comprising a hydroxyl-containing binder (A), a polyisocyanate crosslinking component (B) and a hydrophobic polyester having at least two hydroxyl groups.

Nienhaus et al (6,903,145) disclose a dual curable multicomponent system comprising a polyisocyanate as component (B).

Kyle (5,234,970) discloses a dual curing composition consisting essentially of a isocyanate adduct having free isocyanate groups and polymerizable ethylenically unsaturated groups, reactive (meth)acrylate diluents and a photoinitiator.

Allard et al (6,949,591) disclose a dual curable coating material, as set forth in claims 1-13, comprising a constituent curable by actinic radiation and also by thermal means (a1), a constituent having at least two groups curable by actinic radiation and a thermal crosslinking functional group, a photoinitiator and a reactive diluent.

The instantly claimed invention is also taught in the additional foreign references and US equivalents cited in the International Search Report made of record by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Susan W. Berman/ whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Scidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB  
9/6/2008

/Susan W Berman/  
Primary Examiner  
Art Unit 1796